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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/033,205	12/28/2001	Hyun Jin Kim	EKM-84257	8258

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10/28/2003

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EXAMINER

BUTTNER, DAVID J

ART UNIT

PAPER NUMBER

1712

DATE MAILED: 10/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/033,205

Applicant(s)

KIM, HYUN JIN

Examiner

David Buttner

Art Unit

1712

-- **Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --**
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 4-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

The amendment filed September 9, 2003 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material, which is not supported by the original disclosure, is as follows: The amendment calls for the compositions to be used as a core component. The applicant failed to point out basis on the original specification for support.

Applicant is required to cancel the new matter in the reply to this Office Action.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1 and 4-21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 1 and 18 call for the composition to be used a core component. Applicant has failed to point out basis in the original specification for support.

Claims 1 and 18 call for the "end group" of the copolymer to be a certain structures. Applicant has failed to point out basis in the original specification for support.

Applicant should have specifically pointed out basis for all amendments (MPEP 714.02).

Claims 1, 4, 6-10 and 13-21 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over the Sano '862 Patent.

Sano exemplifies (Table 2) compositions for intermediate layers of golf balls. The composition contains ionomer (applicant's base), HG-252 (applicant's hydroxylated block polymer) and epoxidized block polymer.

The epoxidized block polymer qualifies as an impact modifier because it affects durability (column 4, line 3). It also qualifies as a functionalized copolymer.

Claims 1, 4-11 and 13-21 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over the Yabuki '065 Patent.

Yabuki exemplifies (No. 7) blends of ionomer, HG-252, Himilan 1855 and epoxidized block polymer. Either of the Himilan 1855 and epoxidized block polymer can qualify as part of applicant's base polymer (b).

Takesue '437 (column 2, lines 39, 62) is cited for its description of Himilan 1855 as partially neutralized.

Claims 1, 5-12 and 15-21 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over the Ohkawachi Patent.

Ohkawachi exemplifies (No. 4) a blend of PPE (applicant's polyarylether impact modifier), HG-252 (applicant's block polymer) and PBT (applicant's base polymer).

Applicant's "golf ball component" considered to be nothing more than composition with a stated future intended use. This is due to:

1. Applicant's decision not to claim a "golf ball",
2. Applicant's decision not to provide an explanation of term in the latest response despite the previous 112 system,
3. Applicant's failure to argue that Ohkawachi is not directed to golf balls;
4. Claim 18's method, merely requiring mixing the composition's ingredients, could not form a golf ball

Claims 1, 5-7, 9-12 and 15-21 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 10 and 28 of U.S. Patent No. 6,508,725. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patent claims golf ball materials of polyamide, PPE and a hydroxylated styrene/diene block polymer. The polyamide qualifies as applicant's base and PPE qualifies as applicant's impact modifier.

Applicant's arguments filed September 9, 2003 have been fully considered but they are not persuasive.

Applicant argues the epoxidized styrene/diene block polymers of Sano and Yabuki do not qualify as one of the modifiers listed in the present specification.

Limitations from the specification are not read into the claims (In re Van Genus 26 USPQ 2d 1057; MPEP 2145 VI "Arguing Limitations Which Are Not Claimed").

Applicant's statement is false anyway. The specification does name these epoxidized block polymers (page 12, line 18-25). Applicant actually names the same tradenamed product used by Yabuki (ESBS A1010).

Applicant argues Yabuki's Himilan 1855 cannot qualify as an impact modifier.

Himilan 1855 is a partially neutralized polymer of ethylene/butylacrylate/methacrylic acid. Applicant specifically calls for ethylene polymers functionalized with carboxylic groups (page 11, lines 20-24). Also, note the anhydride and glycidyl functionalized ethylene/acrylate polymers mentioned (page 13 lines 5-12). Himilan has carboxylic groups and is made from ethylene and acrylate. It certainly qualifies as a modifier according to applicant's specifications.

Applicant argues the PPE of Ohkawachi and Kim does not qualify as an impact modifier.

Again, applicant ignores his own specification (page 8, line 10; claim 11) calling for polyarylether as an impact modifier.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Buttner whose telephone number is (703) 308-2403. The examiner can normally be reached on weekdays from 10 a.m. to 5 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Dawson can be reached on (703) 308-2340. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

DAVID J. BUTTNER
PRIMARY EXAMINER

D. Buttner/dh
October 21, 2003

David Buttner